



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,973	03/13/2001	William R. Murray JR.	23068-7367	2624
20350	7590	11/16/2005	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			BARRETT, SUZANNE LALE DINO	
			ART UNIT	PAPER NUMBER
			3676	

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/804,973		MURRAY ET AL.	
	Examiner		Art Unit	
	Suzanne Dino Barrett		3676	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 114-126 is/are pending in the application.
- 4a) Of the above claim(s) 126 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 114, 116-119, 121-124 is/are rejected.
- 7) ☒ Claim(s) 115, 120 and 125 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9/2/05</u> . | 6) <input type="checkbox"/> Other: _____ |

4

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of the embodiment of Figures 11-13 in the reply filed on 8/22/05 is acknowledged. It is noted, however, that claim 126 recites a "flange" which appears to be the embodiment of Fig. 20C, thus claim 126 is withdrawn from consideration as not corresponding to the elected invention.

Claim Objections

2. Claim 114 is objected to because of the following informalities: in line 7 ,after "capable" insert --of-- . Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. Claim 122 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 122, line 1, there is no antecedent basis for "said exterior wall"; it should be changed to --said external wall--.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(c) which forms the basis for all obviousness rejections set forth in this Office action:

(c)(1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

As background for the grounds of rejection under 35 USC 103(c), the following is an excerpt from the Examiner's Answer in application 08/042,581, which became the Carl '685 patent:

Appellants argument in footnote 1 that Carl is not prior art since appellants are also the inventors of the subject matter disclaimed for failure to copy the interference count in the application that became U.S. Patent 5,381,685 and that appellants are, in fact, the inventors of the disclaimed subject matter since “[t]he interference count in question corresponds to a claim which issued in Appellant’s [sic, appellants’] U.S. Patent No. 5,372,752 [sic, 5,327,752] is unpersuasive.

Appellants are not the inventors of the disclaimed subject matter which corresponds to a claim in U.S. Patent 5,327,752. The inventors of the disclaimed subject matter must include Gary L. Myers who is the only actual inventor who cop[ied] a claim corresponding to the count for purposes of interference. The instant application on appeal does not include Mr. Myers as an inventor, but instead includes William R. Murray, Jr. as an inventor. A review of the prosecution histories of the application (08/042,851) which issued into the Carl patent will clearly show that Mr. Carl and Mr. Zarnowitz were the only two inventors who failed to copy the subject matter of a count for purposes of interference and therefore disclaimed such subject matter as being invented by them. The change of inventorship subsequent and the resulting patent is clear evidence that the Carl et al. reference is available to the examiner as prior art. For the convenience of the Board, a copy of the subject matter disclaimed by Mr. Carl and Mr. Zarnowitz is as follows.

Art Unit: 3676

An apparatus for inhibiting theft of equipment having an external wall with a rectangular slot with preselected dimensions, the improvement comprising an attachment mechanism including a housing, a spindle including a first portion rotatably mounted with the housing, a shaft fixed to the first portion and extending outwardly from the housing, and a crossmember conforming closely to the preselected dimensions of the slot and abutment means emanating from the housing and located on opposite sides of the shaft intermediate the housing and the crossmember, the abutment means and the shaft having cross-sectional dimensions closely conforming to the dimensions of the slot so that the crossmember, the shaft and the abutment means are insertable into the slot with the crossmember aligned with the abutment means to a position in which the crossmember is inside the external wall and the abutment means and the shaft occupy the slot, the spindle is rotatable 90 degrees by a locking mechanism to misalign the crossmember with the slot and the abutment means to attach the attachment mechanism rigidly to the external wall; wherein the housing additionally includes a spring for biasing the housing against the external wall upon attachment of the attachment means to the equipment, and a cable connected to an immovable object and secured to the housing to inhibit theft of the equipment.

5. Claims 114,116-119,121,123,124 are rejected under 35 U.S.C. 102(e) or (g) as anticipated by or, in the alternative, under 35 U.S.C. 103(c) as obvious over Carl 5,381,685 in view of Wilson 5,082,232. Carl claims a theft inhibiting device for equipment having an external wall with a rectangular slot with preselected dimensions, the improvement comprising an attachment mechanism including a housing, a spindle including a first portion rotatably mounted with the housing, a shaft fixed to the first portion and extending outwardly from the housing, and a crossmember conforming closely to the preselected dimensions of the slot and abutment means emanating from the housing and located on opposite sides of the shaft intermediate the housing and the crossmember, the abutment means and the shaft having cross-sectional dimensions

Art Unit: 3676

closely conforming to the dimensions of the slot so that the crossmember, the shaft and the abutment means are insertable into the slot with the crossmember aligned with the abutment means to a position in which the crossmember is inside the external wall and the abutment means and the shaft occupy the slot, the spindle is rotatable 90 degrees by a locking mechanism to misalign the crossmember with the slot and the abutment means to attach the attachment mechanism rigidly to the external wall; wherein the housing additionally includes a spring for biasing the housing against the external wall upon attachment of the attachment means to the equipment, and a cable connected to an immovable object and secured to the housing to inhibit theft of the equipment.

Wilson teaches a portable electronic device having a slot in a wall thickness 14, a locking apparatus comprising an attachment mechanism comprising a pin 16 and cylindrical housing 26 and including a slot engaging member 20 insertable into the slot by rotation, and a cable attachment member 12 coupled to the attachment mechanism (22,30), wherein the cable is capable of coupling the portable electronic device to an object (col. 1, line 55). Wilson further teaches the slot engaging member having a cross member at the end of the shaft (head of the screw) to receive a key/tool actuator and wherein the shaft is longer than the thickness of the wall.

It would have been obvious to provide the theft inhibiting device of Carl on equipment such as the portable electronic device taught by Wilson as an obvious matter of design choice.

6. Claim 122 is rejected under 35 U.S.C. 103(c) as being unpatentable over Carl '685 in view of Wilson '232 as applied to claim 114 above and further in view of Sisler

Art Unit: 3676

4,501,460. Sisler teaches a computer/ portable electronic device having a chassis with shell walls formed of molded plastic (col. 2, lines 41-43). It would have been obvious to modify the device of Carl, as modified by Wilson, by providing molded plastic walls, as taught by Sisler to be advantageous in providing durability to the device.

Allowable Subject Matter

7. Claims 115,120,125 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments filed 8/22/05 have been fully considered but they are not persuasive. Firstly, with respect to Applicant's argument that 102(g) is not applicable, it is maintained that in view of the examiner's argument set forth in the Examiner's Answer of the 08/042,851 application (Carl '685), excerpted above, 35 USC 102(g) is applicable. Applicant is directed to parent application 07/824,964 (of which 08/042,851 is a continuation), paper no. 3, mailed 10/06/92, pages 5-7, in which the examiner first proposed copying a count for the purposes of interference. The Examiner stated that: "The suggested claim must be copied exactly, although other claims may be proposed under 37 C.F.R. 1.605(a).

Applicant should make the suggested claim within one month from the date of this letter. Failure to do so will be considered a disclaimer of the subject matter of this claim under the provisions

of 37 C.F.R. 1.605(a). The extension of time provisions of 37 C.F.R. 1.136(a) do not apply to this time period.”

It is noted that Applicant failed to copy the proposed count in the allotted time and therefore disclaimed the subject matter therein. Since Myers copied the count in the application which became the 5,327,752 patent, the invention is deemed to be his. Accordingly, the instant claims must be unobvious over the count, otherwise Myers must be added as an inventor. Therefore, the use of Carl '685 under 102(g) is proper.

Secondly, regarding Applicant's assertion that the Board of Appeals already considered the Carl reference under 102(g), the examiner disagrees, since it is clear from the record that the Board only considered the embodiment of Figure 19, while the instant application considers the elected embodiment of Figures 11-13. Furthermore, the Board only spoke to the Figure 19 embodiment and was silent as to the inventorship issue.

Accordingly, claims 114,116-119,121-124 stand non-finally rejected.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suzanne Dino Barrett whose telephone number is 571-272-7053. The examiner can normally be reached on M-Th 8:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on 571-272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3676

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Suzanne Dino Barrett
Primary Examiner
Art Unit 3676

sdb
11/10/05